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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,204	08/02/2001	Christopher S. Autterson	AAS104A	5914

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09/20/2004

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EXAMINER

PICKETT, JOHN G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,204

Applicant(s)

AUTTERSON, CHRISTOPHER S.

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office action acknowledges the applicant's Amendment submitted 26 February 2004. Claims 1 and 11 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. As the examiner introduces new grounds of rejection, this Office Action is made **NON-FINAL**.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The definition of affiliate is to connect or associate with. Once the first and second parties enter into agreement to display their advertisements on the same container, they become loosely affiliated within the broadest meaning of the term. As such the claim language of claims 1 and 11 have the first and second parties both

affiliated by their agreement on advertisement display and also "not affiliated in any way". To prosecute the examination of the claims on their merits, the examiner interprets the term "affiliated" to be directed only to ownership (i.e. the second party is not owned by the first party).

Claim Rejections - 35 USC § 103

5. Claims 1 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bichaylo et al (US 3,498,815) in view of the practice of placing advertisements for missing children on milk cartons (hereinafter missing-child).

Regarding the method of claim 1, Bichaylo is exemplary of a standard milk carton with advertisements 66 printed on predetermined panels. Bichaylo does not expressly disclose the owner of the carton. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the milk company also own the carton in order to reduce the number of parties to which profit must be distributed. As such the milk company is considered the first party.

The examiner takes Official Notice that the printing of advertisements of missing children on side panels of milk cartons, as a public service, was known in the art at the time the instant invention was made. Applicant, of course, has the right to challenge this Official Notice in response to this decision and demand production of evidence in support thereof, provided such challenge is accompanied by adequate information or argument that, on its face, creates a reasonable doubt regarding the circumstances

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justifying the Official Notice. *In Re Boon*, 439 F.2d 724, 169 USPQ 231, 234 (CCPA 1971). As such, the missing-child agency is considered the second party.

As most missing-child agencies are non-profit agencies (such as Child Quest or the National Center for Missing and Exploited Children), it is deemed obvious that the second party is not affiliated (i.e. owned) with the first party, and is therefore separate and distinct.

As to the simultaneous printing, it would have been obvious to one of ordinary skill in the art at the time the invention was made to print the advertisements simultaneously in order to reduce the steps in manufacturing.

As to the printing on an otherwise blank area, Bichaylo discloses printing on unprinted areas of the blank (see Col. 4, lines 35-40).

Since the first party owns the carton, it would have been obvious for the first party to allot the area, and determine the size and location for the second advertisement so as not to interfere with the primary graphics of the first advertisement.

As the second advertisement is considered a public service, it would have been obvious for the second advertisement to be provided by the second party without the first party buying the second advertisement.

As the size of the container limits overall size of the advertisements, the size of the second advertisement is determined, at least in part, by the size of the container.

Regarding claim 11, the container formed by the method of Bichaylo-missing-child discloses the claimed invention.

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6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over MacGuire (US 2003/0141214 A1).

Claim 11 is a product-by-process claim.

MacGuire discloses a shipping packaging container (2a-2d) with an outer and inner surface, a first advertisement (SOAP) provided by a first party (manufacturer) on a first predetermined area, a second advertisement (2a'-2d') provided by a second party (operating entity) on a second predetermined area, the second party is not affiliated in any way to the first party, and the first party determines the second predetermined area (see for example paragraph [0056]).

MacGuire meets all limitations claimed by the applicant except:

MacGuire lacks or does not expressly disclose that the second predetermined area would otherwise be blank or that the size of the second advertisement is determined, at least in part, by the shipping/packaging container size. It would have been obvious to one of ordinary skill in the art at the time the invention was made to place the second advertisement on an area that would otherwise be blank in order to avoid covering important consumer information. It would have further been obvious to one of ordinary skill in the art at the time the invention was made to size the second advertisement to fit the container. A one-foot square second advertisement would obviously be inappropriate for a two-inch cube container.

As to the first and second advertisement being both printed on the container at the same time, the method of forming the device is not germane to the issue of patentability of the device itself. If the product in the product-by-process claim is the

same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kapp (US 5,246,161).

Claim 11 is a product-by-process claim.

Kapp discloses a shipping/packaging container (10) with first advertisement (indicia on panel 14) in a first predetermined area and second advertisement (indicia on panel 12) in a second predetermined area.

Kapp discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the indicia in the claimed arrangement and content since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of advertisement does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious

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functional relationship between the printed matter, e.g. indicia on panels 12 and 14, and the substrate, e.g. the box, which is required for patentability.

As to the ownership of the indicia, the ownership and the affiliation of the parties owning said indicia are deemed an intended use. It has been held that a recitation with respect to the manner in which the claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ2d 1647 (1987). The only structure currently claimed is a container with two forms of indicia in two locations.

As to the size of the indicia, Kapp discloses the claimed invention except for who or what determines the size and location. It would have been an obvious matter of design choice to change the size of the advertisement or to select the size based upon the container size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). The provision of who determines the size is deemed an intended use. It has been held that a recitation with respect to the manner in which the claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. *Ex Parte Masham*, 2 USPQ2d 1647 (1987).

As to the simultaneous printing, the method of forming the device is not germane to the issue patentability of the device itself. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable

even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Response to Arguments

8. Applicant's arguments, filed 26 February 2004, regarding claim 11, have been fully considered but they are not persuasive. The method of forming the device is not germane to the issue of patentability of the device itself. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

9. The applicant's arguments concerning the term "advertisement" are moot in view of the new grounds of rejection.

Conclusion

10. As the examiner has introduced new grounds of rejection, this Office Action is made **NON-FINAL**.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hirahara discloses the use of a package as a tool for advertising.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GP

Gregory Pickett
Examiner
24 August 2004



Mickey Yu
Supervisory Patent Examiner
Group 3700